

REMARKS

I. Introduction

Claims 8 to 14 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited reference.

II. Rejection of Claims 8 to 14 Under 35 U.S.C. § 103(a)

Claims 8 to 14 were rejected as being unpatentable over U.S. Patent No. 5,915,276 ("Fell"). Applicants respectfully submit that Fell does not render obvious the present claims as amended herein for the following reasons.

Claim 8 relates to a micromechanical yaw rate sensor. Claim 8 recites that the micromechanical yaw rate sensor includes a substrate, a bridge, an anchoring device provided on the substrate and including two opposite bases that are connected fixedly with the substrate and that are connected with one another via the bridge, a flexural spring device, and an annular flywheel that is connected via the flexural spring device with the anchoring device such that an area of connection with the anchoring device is located essentially in a center of a ring of the flexural spring device, so that the annular flywheel is displaceable, elastically from a rest position, about an axis of rotation situated perpendicular to a surface of the substrate, and about at least one axis of rotation situated parallel to the surface of the substrate. Claim 8 further recites that at least one V-shaped flexural spring of the flexural spring device is attached to each of opposite sides of the bridge in such a way that an apex is situated on the bridge and limbs of the bridge are spread towards the annular flywheel with an opening angle.

As indicated above, claim 8 recites "an anchoring device . . . including two opposite bases that are connected fixedly with the substrate and that are connected with one another via the bridge." The Office Action admits that "Fell lacks the detail of an anchoring device including two opposite bases." Office Action at p.

2. Based on this admission, it is respectfully submitted that Fell does not render obvious claim 8 to 14.

The Office Action's reliance on In re Kuhla, 526 F.2d 553, 188 U.S.P.Q. 7 (C.C.P.A. 1975) and In re Karlson, 311 F.2d 581, 136 U.S.P.Q. 184 (C.C.P.A. 1963) is misplaced. These cases relate to the issue of whether the elimination a particular element described in a prior art reference along with the elimination of its function is obvious. Contrary to these decisions, claims 8 to 14 of the present application do not reflect the elimination of any element described by Fell. Rather, Fell, as admitted in the Office Action, fails to disclose the anchoring device as recited in claim 8. Accordingly, Fell does not render obvious claim 8.

The unsupported assertions that "four support legs . . . are equivalent to flexural spring device," "a rim ring 7 . . . is equivalent to a flywheel," and "a structure 6 that is located via the boss 9 on an [sic] substrate . . . is equivalent to a bridge" are traversed, and Applicants respectfully request that the Office produce authority for these otherwise conclusory statements.

The structure 6 that is located via the boss 9 on a substrate 21 discussed by Fell is not arranged in the same manner as the bridge set forth in claim 8. The structure discussed in Fell only allows "rotations around one or other of the two axes." Col 5, lines 17 to 18. In contrast, claim 8 recites that the anchoring device allows the "annular flywheel . . . to be displaced . . . about an axis of rotation situated perpendicular to a surface of the substrate." In addition, the Office Action does not discuss any suggestion to modify Fell's structure by incorporating two opposite bases in the anchoring device.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, supra. This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As

indicated above, Fell does not disclose, or even suggest, all of the limitations of claim 8. It is therefore respectfully submitted that Fell does not render obvious claim 8.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects, at best, a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have

indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not the case here -- there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab’s invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

With respect to claims 11 and 13, the Office Action alleges that certain recited features are well known in the art. Applicants respectfully traverse these contentions to the extent that they are maintained and request that the Examiner provide specific evidence to establish those assertions and/or contentions under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because this rejection is apparently being based on assertions that draw on facts within the personal knowledge of the

Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also M.P.E.P. § 2144.03).

Moreover, judicial or official notice that is based on subjective and unsupported reasoning will not sustain an obviousness rejection. In the M.P.E.P. cited case of In re Ahlert, 165 U.S.P.Q. 418, 420 to 421 (C.C.P.A. 1970), the Court made plain that:

Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. **Allegations concerning specific "knowledge" of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.**

In re Ahlert, 165 U.S.P.Q. at 420 to 421 (citations omitted).

Otherwise, if the Examiner cannot provide either references or an affidavit to support these contentions, it is respectfully requested that the rejections of the claims under 35 U.S.C. § 103 be withdrawn for this reason alone.

In addition, claims 9 to 14 ultimately depend from claim 8 and therefore include all of the limitations of claim 8. As set forth above, Fell does not disclose, or even suggest, all the limitations of claim 8. It is therefore respectfully submitted that claims 9 to 14 are patentable over Fell. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: August 6, 2003

By: Richard L. Mayer

Richard L. Mayer
Reg. No. 22,490

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

Reg. No. 42,194